

PTO/SB/17 (01-06)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 400.00

Complete if Known

Application Number 09/559,704
 Filing Date 04/27/2000
 First Named Inventor Michael Zoeckler
 Examiner Name Harmon, Christopher R.
 Art Unit 3721
 Attorney Docket No. R029 1056

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):
☒ Deposit Account Deposit Account Number: 09-0528 Deposit Account Name: Womble Carlyle Sandridge & Rice, PLLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)
 Each independent claim over 3 (including Reissues)
 Multiple dependent claims

	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims Extra Claims Fee (\$)
 - 20 or HP = x =
 HP = highest number of total claims paid for, if greater than 20.
 Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)
 - 3 or HP = x =
 HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$)
 - 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Petition Fee

Fees Paid (\$)

\$400.00

SUBMITTED BY

Signature *Keats A. Quinalty* Registration No. 46,426 Telephone 404-879-2423
 Name (Print/Type) Keats A. Quinalty Date 5/12/06

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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From: Keats A. Quinalty
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Attorney Number: 1679

TO:	Mail Stop AF	COMPANY:	Commissioner for Patents
FAX:	571-273-8300	PAGES:	10 (including cover)
PHONE:		DATE:	May 12, 2006
RE:	U.S. Application Serial No. 09/559,704	ATTORNEY DOCKET/REF. NO.	R029 1056
		ACCOUNTING NO.	38400.0038.8

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In re Application of: Michael D. Zoeckler

OFFICIAL

Serial No.: 09/559,704

Filing Date: 04/27/2000

For: Paperboard Cartons with Laminated Reinforcing Ribbons and Method of Making Same

Attached in connection with the above-identified patent application are the following:

- (1) Transmittal Form;
- (2) Petition to the Director; and
- (3) Fee Transmittal.

1201 West Peachtree Street, Suite 3500 Atlanta, GA 30309-3574 Telephone (404) 872-7000 Fax: (404) 888-7490

WCSR 2357833v1

PTO/SB/21 (09-04)

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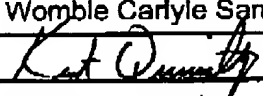
TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/559,704	
	Filing Date	04/27/2000	
	First Named Inventor	Michael D. Zoekler	
	Art Unit	3721	
	Examiner Name	Harmon, Christopher R.	
Total Number of Pages in This Submission	9	Attorney Docket Number	R029 1056 (7137)

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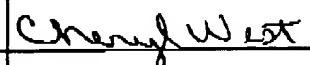
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ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Womble Carlyle Sandridge & Rice, PLLC		
Signature			
Printed name	Keats A. Quinalty		
Date	5/12/06	Reg. No.	46,426

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:	
Signature	
Typed or printed name	Cheryl West
Date	5-12-06

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael D. Zoeckler)	Examiner: Harmon, Christopher R.
Serial No.: 09/559,704)	Art Unit: 3721
Filed: 04/27/2000)	Attorney Docket No.: 7137 (R029 1056)
For: PAPERBOARD CARTONS WITH)	
LAMINATED REINFORCING RIBBONS)	
AND METHOD OF MAKING SAME)	

PETITION TO THE DIRECTOR

Mail Stop Petitions
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Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.181(a), Applicant/Appellant hereby petitions the Director of the PTO to instruct the Examiner to withdraw the Non-Final Office Action mailed April 19, 2006 and to issue in its place a Replacement Examiner's Answer. Prosecution of the present application should not be reopened for at least the following reasons: (1) reopening prosecution is not appropriate at this stage of appeal since a Reply Brief already has been filed, entered, and considered, (2) reopening prosecution unnecessarily delays a decision by the Board in the present application and frustrates the desire of Applicant/Appellant to have the Board address the present application at the same time as two other applications in this patent family, both of which currently are under appeal, (3) with the exception of two sentences added, the present Non-Final Office Action is merely a reiteration of the prior statements and arguments presented by the Examiner in

his earlier rejections and Examiner's Answer in the prior appeal of the present application and fails to address each of the Board's stated concerns of lack of support for the rejections and requests for additional information, and (4) the Director has the authority to remedy the misstep of reopening prosecution.

Background of Application:

A Notice of Appeal was filed in the present application on September 1, 2004.

Subsequently, an Appeal Brief and a number of replacement Appeal Briefs were filed responsive to defective Appeal Brief notices (to address the rule changes that took effect September 13, 2004). In one section, the Appeal Brief addressed a single reference final rejection under 35 USC § 103 over *Lang*. In response to the Appeal Brief, an Examiner's Answer was issued on February 24, 2005.

The Examiner's Answer modified the single reference rejection based upon *Lang* to a rejection based on *Lang* in view of *Campbell*. Applicant/Appellant considered that both the rejection based on *Lang* and the rejection based on *Lang* in view of *Campbell* were improper on the merits, and did not object to the modification of the § 103 rejection. Instead, Applicant/Appellant proceeded to file its Reply Brief on April 25, 2005 to maintain the appeal before the Board. Applicant/Appellant is not interested in prosecution being reopened in contemplation of the same rejections being once again applied by the Examiner, but rather wishes to have this matter decided as expeditiously as possible without further delay in the prosecution and issuance of the present application.

On September 28, 2005, the Board returned the appeal to the Examiner, citing new rule 37 CFR § 41.39, to address the Examiner's inclusion of a new ground of rejection in the Examiner's Answer. The Board reminded the Examiner on page 4 of the Remand that

"in order to include a new ground of rejection in the Examiner's Answer, the Examiner must follow the guidelines set forth in training material entitled 'Rules of

Practice Before the Board of Patent Appeals and Interferences, Final Rule,' located at the following URL: www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html.

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed February 24, 2005. Once the Examiner's Answer mailed February 24, 2005 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection."

In response, the acting SPE filed an Official Communication that indicated among other things that

"the Examiner believes the action taken in the Examiner's Answer of 2/24/05, i.e. providing concrete evidence of the patent to *Campbell et al.* in order to satisfy the substantial evidence test, was proper and thus does not contain a new grounds of rejection. The Appeal is returned to the Board of Patent Appeals for further and appropriate action."

The application was returned to the Board on October 31, 2005 to consider the appeal. The Board then issued a further Remand to the Examiner on March 24, 2006, noting that the rejection based upon *Lang* in view of *Campbell* was a new ground of rejection and that the Examiner should proceed according to the instructions as provided in the original Remand dated September 28, 2005.

In response, the Examiner reopened prosecution and mailed a non-final action on April 19, 2006 that was essentially devoid of any additional information or support to justify reopening prosecution. In fact, with the exception of the addition of approximately two sentences and the subtraction of a number of sentences, the non-final action issued April 19, 2006 is little more than a regurgitation of the same positions stated by the Examiner throughout the prosecution and the appeal of this application.

In response, Applicant/Appellant contacted the Supervisor of the Art Unit in which the application is pending to request that prosecution not be reopened, that the non-final action dated April 19, 2006 be withdrawn, and that a Replacement Examiner's Answer be issued. If so retitled, the Replacement Examiner's Answer would be required to be approved by a Technology Center Director or designee. The Supervisor indicated that the Applicant/Appellant should file the present Petition to the Director since he supported the reopening of prosecution and issuance of the non-final rejection mailed April 19, 2006. Since Applicant/Appellant believes that continuing prosecution at this stage would be counterproductive and would only further unnecessarily delay the prosecution of this application, Applicant/Appellant has filed the present Petition to continue the appeal. In contemplation of the time period that elapses during appeals, and in case the present Petition is denied, Applicant/Appellant has filed a Notice of Appeal together with the present Petition.

The Director should also be aware that this application is one of three applications pending appeal before the Board, all of which were scheduled for oral hearing at the same time for the benefit of the Board and the Appellant. However, while the other two applications remain pending before the Board, the instant application is the only one in which prosecution has been reopened.

PROSECUTION SHOULD NOT BE REOPENED

1. Reopening prosecution is not appropriate at this stage.

Reopening prosecution is not appropriate at this stage during appeal of this application since a Reply Brief has been filed, entered, and considered. The Applicant/Appellant filed the Reply Brief dated April 25, 2005 in response to the Examiner's Answer that included the new ground of rejection. Applicant/Appellant did not object to entry of the new ground of rejection since Applicant/Appellant believes that either rejection, one based on *Lang* alone or one based on *Lang* in view of *Campbell*, is improper on its merits, whether new or not. The Examiner has failed to provide any support, other than his own suppositions, that a rejection based on *Lang* alone or based on *Lang* in view of *Campbell* is proper under 35 U.S.C. § 103(a). Additionally, the proposed combination of *Lang* with *Campbell* is supported only by the Examiner's suppositions and not by a supportive teaching or suggestion in either reference. Applicant/Appellant avers that since the Reply Brief was filed and entered, the appropriate action in this situation is to issue a Replacement Examiner's Answer, with approval by the Technology Center Director to include the new ground of rejection.

2. Reopening prosecution unnecessarily delays the present application.

Since Applicant/Appellant desires that the Board address the rejections of this application in conjunction with the two other related applications that are on appeal, reopening of prosecution merely for the Examiner to repeat rejections already of record unnecessarily delays the furtherance of this application. Since the rejections in all three of these related applications, all before the same Examiner, are improper and lack necessary support, Applicant/Appellant desires that the Board address these applications together. Applicant/Appellant is not interested in any manner in continuing to address before the Examiner what are essentially the same rejections and instead

desires an audience before the Board to resolve these rejections once and for all without further delay. Applicant/Appellant believes that this application continues to be ripe for decision by the Board and that reopening prosecution to rehash the same, or substantially the same, rejections merely presents an unwarranted and unnecessary delay. If the present Petition is denied and if the appeal process must be restarted, Applicant/Appellant will be significantly prejudiced by delay, considering the number of cases already before the Board. Also, the Board will be required to re-educate itself on a substantial portion of similar material many months in the future merely because prosecution has been reopened.

3. The non-final rejection adds nothing to the record before the Board.

With the exception of approximately two sentences added and multiple sentences subtracted, the Non-Final Action dated April 19, 2006 is merely a regurgitation of prior statements/arguments made by the Examiner. The Non-Final Action further fails to address each of the requests or comments provided by the Board. For example, the Non-Final Office Action fails to address the three additional patents cited in the office action in reference to the final paragraph on page 5 of the Remand by the Board mailed March 24, 2006. Since the Non-Final Office Action fails to provide any additional information, support, or new substantive arguments whatsoever, there is absolutely no reason to reopen prosecution. Applicant/Appellant therefore requests that the Non-Final Office Action be withdrawn and a Replacement Examiner's Answer in accordance with 37 CFR § 41.39 be issued.

4. The Director has the discretion to remedy the immediate situation addressed by this Petition.

Pursuant to 37 CFR § 1.181(a), Applicant/Appellant avers that the Director of the PTO has the authority to remedy the missteps of reopening prosecution and issuance of the Non-Final Action

dated April 19, 2006, and to require the Examiner to issue a Replacement Examiner's Answer that addresses entirely the instructions of the Board in the Remand issued March 24, 2006.

Accordingly, Applicant/Appellant requests that the Director order that prosecution not be reopened, that the Non-Final Office Action of April 19, 2006 be withdrawn, and that the Examiner issue a Replacement Examiner's Answer for continuation of the appeal to the present application.

CONCLUSION

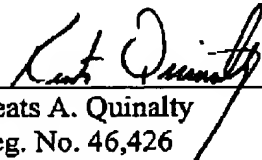
For the foregoing reasons, the Examiner's reopening of prosecution and issuance of a non-final rejection were improper and should be withdrawn.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Petition to Deposit Account No. 09-0528.

Respectfully submitted,

5/12/06
Date



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Barry D. Biddle
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